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IN THE

# Supreme Court of the United States

MAURICE MITCHELL INNOVATIONS, L.P.,

*Petitioner,*

*v.*

INTEL CORPORATION,

*Respondent.*

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

## REPLY BRIEF

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## CORPORATE DISCLOSURE STATEMENT

Petitioner's corporate disclosure statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that statement.

## I. The Question Before The Court Is One Of Fact Not Properly Decided On Summary Judgment, And Respondent Incorrectly Argues That It Is A Question Of Law

Respondent Intel, in its opposition, incorrectly argues that the question presently before this Court is one of law. For that proposition, Intel cites language of the Federal Circuit Court of Appeals in *AllVoice Computing PLC v. Nuance Comm. Inc.*, holding that "existence of the requisite corresponding structure for a means-plus-function claim limitation is a question of law." (Opp. 12; 504 F.3d 1236, 1240-41 (Fed Cir. 2007)) However, this standard is true only in the context of claim construction. Here, Petitioner Mitchell does not appeal a claim construction order, but rather the Court of Appeals' affirmance of the trial court's grant of summary judgment, which involved interpretation of the patent specification *subsequent to* claim construction. The question before this Court and the courts below is one of fact.

In its September 24, 2007 opinion in this matter, the Court of Appeals summarized the procedural background of this case, correctly stating that "the district court adopted the claim construction of District Judge Susan Illston of the United States District Court for the Northern District of California. . . The district court *then* determined that the '154 patent specification did not disclose structure" for the means-plus-function limitations. (App. A at 6a, emphasis added.) The courts below in the instant case had completed the claim construction phase of the analysis and moved onto the factual inquiry regarding the written description of the invention in the patent specification. This factual inquiry is to be undertaken by the fact-finder based upon the understanding of a person of ordinary skill in the art, not by the court based upon its own understanding.

Respondent's opposition brief undeniably confirms that the procedural posture of the courts below places the question at hand *outside* the scope of claim construction. Respondent writes, "[t]he court deferred for disposition on summary judgment the issue of whether the patent's written specification sufficiently disclosed corresponding structure . . ." (Opp. 2.) The district court's claim construction order was issued on June 21, 2006. The district court *then* reviewed separate briefing on the issue of the specification's written description, accepting briefs and evidence from the parties on the issue of invalidity and the propriety of summary judgment between July 27, 2006 and August 25, 2006, and issued its summary judgment ruling on November 22, 2006. The facts and procedural history of the case demonstrate that the district court's review of the patent specification was conducted after the conclusion of claim construction and during the summary judgment phase of the litigation. Therefore, any determination regarding the meaning of the written description to one of ordinary skill in the art is a question of fact that must be based upon record evidence. The written opinions of both courts below clearly show the failure to accomplish this critical step - a step that has long been mandated by this Court, as detailed in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684 (1966), and its progeny.

It is well-settled under Federal Circuit law that interpretation, after claim construction, of a patent specification's compliance with § 112 is a question of fact. The precedents of the Federal Circuit Court of Appeals "provide that compliance with the 'written description' requirement of § 112 is a question of fact, to be reviewed under the clearly erroneous standard." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). The Federal Circuit Court of Appeals has consistently stated that

"[w]ritten description is a question of fact, judged from the perspective of one of ordinary skill in the art as of the relevant filing date." *Mukherjee v. Chu*, 217 Fed. Appx. 971, 974 (Fed. Cir. 2007); *see also Kao Corp. v. Unilever U.S., Inc.*, 441 F.3d 963, 967 (Fed. Cir. 2006) (compliance with the written description requirement is a question of fact.)

The very case that Respondent Intel relies upon in its opposition to this petition further confirms Petitioner Mitchell's position. In *AllVoice Computing*, *supra* at 1, the district court improperly ignored the only record evidence presented by an expert witness qualified to elucidate the understanding of a person of skill in the art at the time of the invention. The Court of Appeals therefore reversed both the district court's holding of invalidity and grant of summary judgment based upon the statement of the plaintiff's expert that "[a] person skilled in the art reading the '273 specification . . . would know the software to use and how to implement it." *Id.* at 1246. The Court of Appeals concluded that "[w]ithout any record evidence to contradict [the expert's] assessment, this court discerns that the district court erred in this indefiniteness judgment." *Id.* The district court improperly treated the question as a matter of law to be determined by the court. The decision of the Court of Appeals makes clear that the questions to be determined by the court in *AllVoice* were questions of fact that were to be analyzed with the understanding of a person of ordinary skill in the art. The same type of expert witness evidence has been proffered here, and the interpretation of the written description of Petitioner Mitchell's '154 patent specification in view of that evidence is similarly a question of fact.

## II. The Courts Below Have Misapplied Precedent Regarding Important Federal Law And Respondent Incorrectly Argues That Petitioner Seeks To Be Heard Based Upon Factual Error

Respondent Intel attempts to minimize the issue before the Court, characterizing Petitioner Mitchell's argument as having "not even a whiff of controversy" (Opp. 6) and a "fallback argument [which] is nothing more than a call for reversal based on alleged factual error." (Opp. 7.) As Petitioner Mitchell has made clear in its petition and herein, the true issue here is whether a court may properly grant summary judgment in a patent matter by interpreting the patent's specification based upon its own understanding without regard to the testimony in evidence of a person of ordinary skill in the art.

Respondent Intel claims that "both courts explicitly considered the sections [of the specification] relied on by Dr. Patterson. (Pet. 8a-11a, 23a-28a.)" (Opp. 7). However, a careful reading of the cited sections of the courts' opinions shows that nowhere does either court consider Dr. Patterson's unrebutted interpretation of the sections as a person of ordinary skill in the art. Rather, both lower courts impose their layman's opinion. In so doing, the lower courts have committed errors of law conflicting with the well established precedents of this Court requiring that the specification be read from the understanding of a person of ordinary skill in the art at the time of the invention.

Here, Petitioner Mitchell has provided record evidence of a person of ordinary skill in the art at the time of the invention. Respondent Intel has completely failed to present any record evidence. The only record evidence regarding the understanding of a person of ordinary skill

in the art is that of Dr. Patterson, one who can competently testify as to that skill as it existed some 25 years ago when Petitioner Mitchell's '154 patent was initially filed. This evidence was wholly ignored by the lower courts. While Petitioner Mitchell does believe that the courts below have made erroneous factual determinations, the error addressed in this petition is the lower courts' deviation from this Court's legal precedent by carrying out that factual interpretation of the written description of the '154 patent without reference to the understanding of a person of ordinary skill in the art.

The courts below have rendered decisions conflicting with the precedent of this Court with respect to the standard of review on summary judgment and the weighing of fact-based evidence. The holdings below are inconsistent with the precedent of this Court and the Court of Appeals for the Federal Circuit regarding the interpretation of a patent's written specification. Petitioner Mitchell respectfully requests that the Court grant its petition for a writ of certiorari so that the Court may resolve these inquiries. Only by granting such petition may the Court address these important federal questions, which impact every patent litigation matter.

## CONCLUSION

For the foregoing reasons and those set forth in Petitioner Mitchell's petition filed on January 18, 2008, Petitioner Mitchell respectfully requests that the Court issue a writ of certiorari in this matter.

Respectfully submitted,

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